

Appl. No. 10/716,133
Atty. Docket No. CM2542CQ
Amdt. dated January 18, 2006
Reply to Office Action of October 18, 2005
Customer No. 27752

REMARKS

Claim Status

Claims 1 - 20 are pending in the present application. Claims 1-14 and 20 have been withdrawn from consideration.

Claims 15-17 have been amended in accordance with the suggestions by the Office. See the rejections by the Office under 35 U.S.C. § 112, first paragraph. Support for these amendments can be found in the specification, for example, on page 6, lines 27-28; page 8, lines 1-2; page 8, lines 11-13. Additionally, claim 15 has been amended to more specifically characterize the present invention. Support for this amendment can be found on page 5, lines 2-5.

In addition, new Claims 21 and 22 have been added. Support for these amendments is found in the specification, for example, at page 5, lines 2-6.

Claims 1-14 and 20 have been withdrawn as a result of an earlier restriction requirement.

It is believed these changes do not involve any introduction of new matter. Consequently, entry of these changes is believed to be in order and is respectfully requested.

Rejection Under 35 USC §112, Second Paragraph

The Office Action states that claims 15-16 and 18 are rejected under 35 U.S.C. § 112 second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. Specifically, the Office Action asserts that the claim recites "at process temperature" but does not disclose a process temperature or a range of temperatures. Applicant respectfully traverses the rejection by the Office Action.

The requirement of 35 U.S.C. § 112 second paragraph is two fold. (See MPEP § 2171). First, "the claims must set forth the subject matter that applicants regard as their invention." *Id.* Second, "the claims must particularly point out and distinctly define the metes and bounds of the subject matter that will be protected by the patent grant." *Id.* Regarding the first requirement, "[a] rejection based on the failure to satisfy this

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requirement is appropriate only where applicant has stated, somewhere other than in the application as filed, that the invention is something different from what is defined by the claims." MPEP § 2172 (I). The second requirement "is evaluated in the context of whether the claim is definite - i.e., whether the scope of the claim is clear to a hypothetical person possessing the ordinary level of skill in the pertinent art." MPEP § 2171.

The application states that "[t]he process temperature, when used herein is the temperature of the surface of the transfer tool or of the tool as a whole." (page 7, lines 26-27). Additionally, the specification states that "[p]referred process temperatures can for example be from 80°C to 250°C, or more preferably from 110°C to 175°C, preferably 130°C to 170°C." (page 13, lines 33-34). Moreover, the transfer tool 200 is shown in Figures 1 and 3. Applicants assert that a person possessing the ordinary level of skill in the pertinent art would find the claim term "at process temperature" to be clear based on the specification.

Rejection Under 35 USC § 112, First Paragraph

The Office has rejected claims 15-19 under 35 U.S.C. § 112, first paragraph, for non-enablement of a sticky material with a peel force of 0.1 N/cm. The Office states that "[a] specific amount of sticky material applied for the peel force measurement must be included in the claim to render enablement." Applicants have amended claims 15 and 17 such that a specific amount of sticky material is included in these claims.

Additionally, the Office has rejected claims 15, 16, and 18, under 35 U.S.C. § 112, first paragraph, for non-enablement for an elastic modulus which increases from 10 to 10,000 Pa in less than a 60°C temperature range. The Office states that "[t]he frequency of the oscillating plates used to measure elastic modulus and loss tangent must be included in the claims language in order to be enabling." Applicants have amended claims 15 and 16 such that the frequency of the oscillating plates used to measure the elastic modulus and loss tangent are included in these claims.

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Rejection Under 35 USC §102 Over Karim et al.

Claims 15 and 18 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application Publication No. 2001/0007003, filed in the name of Karim et al., hereafter, "Karim". Applicants respectfully traverse the rejection by the Office.

It is well established that a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Karim fails to teach all of the claim elements of amended claim 15.

Amended claim 15 recites, in part, that the sticky material has "a viscosity η of less than 2500 mPa.s at process temperature." Karim teaches "[t]hermosettable PSA compositions" comprising "a major proportion of the adhesive component of at least one acidic polymer and at least one amine-containing compound capable of reacting with acidic functional groups on the acidic polymer." (Abstract). However, Karim does not teach a sticky material having "a viscosity η of less than 2500 mPa.s at process temperature", as is recited, in part, in amended claim 15.

Because Karim does not teach all of the claim elements of amended claim 15, Applicants assert that amended claim 15 is not anticipated by Karim. Additionally, because claim 18 depends from claim 15, Applicants assert that Karim similarly fails to anticipate claim 18. Accordingly, Applicants assert that claims 15 and 18 are in condition for allowance.

Rejection Under 35 USC §103(a) Over Coles et al.

Claims 15-19 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,613,030 issued to Coles et al., hereafter "Coles". Applicants respectfully traverse the rejection by the Office.

It is well established that in order to establish a prima facie case of obviousness, three requirements must be met. MPEP §2143. First, there must be some suggestion or motivation, either in the cited references or in the knowledge generally available to one ordinarily skilled in the art, to modify the reference. *Id.* Second, there must be some reasonable expectation of success. *Id.* Third, the cited references must teach or suggest all of the claim limitations. *Id.*

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Coles does not teach all of the claim elements of amended claim 15. Coles teaches disposable absorbent article which include adhesives, wherein the adhesives are used "for attachment of the article to the skin" providing secure attachment of the article to the skin, "are pleasing to the skin upon application," and "cause no discomfort upon removal." (Abstract). Coles further teaches that "[t]he adhesive is applied on at least a portion of the wearer facing surface of the disposable absorbent article." (col. 16, lines 19-20).


In contrast, amended claim 15 recites, in part, "wherein the sticky material is disposed on a garment facing surface of the absorbent article." As discussed above, Coles does not teach or suggest this claim element of amended claim 15. Consequently, Applicants assert that a *prima facie* case of obviousness has not been established against amended claim 15.

For the foregoing reasons Applicants assert that amended claim 15 is nonobvious over Coles. Additionally, because claims 16-19 depend from claim 15, Applicants assert that claims 16-19 are also nonobvious over Coles.

Conclusion

In light of the above remarks, it is requested that the Examiner reconsider and withdraw the rejection under 35 U.S.C. § 112, first paragraph, second paragraph, § 102(e), and § 103(a). Early and favorable action in the case is respectfully requested.

Respectfully submitted,

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